

REMARKS

Upon entry of the present amendment, claims 3-5, 10-15 and 16-21 will remain pending in the above-identified application with claims 3-5 and 10-15 being withdrawn based upon an earlier Restriction Requirement and remaining claims 16-21 standing ready for further action on the merits.

No new matter is being introduced by the present amendments to the claims. For example, newly added claims 16-19 are based on prior claims 6, 7 and 9. Newly added claim 20 finds support at page 8, lines 12-17 and at page 21, line 19 to page 22, line 8 of the specification, and newly added claim 21 finds support at page 9, lines 11-21 and at page 21, line 19 to page 22, line 8 of the specification.

Accordingly, entry of the instant amendment and proper consideration of each of instant claims 16-21 is requested at present.

Claim Objection

Claims 6, 7 and 9 have been objected to under 37 CFR § 1.75(c) as being of an improper dependent form. However, since these claims have been canceled, and none of the remaining claims under consideration are of an improper dependent form, it is submitted that this objection has been rendered moot and must therefore be withdrawn.

Claim Rejections under 35 USC § 102(b)

The USPTO sets forth a rejection of claims 1, 2 and 8 under 35 USC § 102(e) over Wake US '811 (US 6,436,811). Applicants traverse this rejection, and respectfully request reconsideration and withdrawal thereof, based on the following facts.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

The present invention is directed to a polishing composition as recited in sole independent claim 16. The polishing agent of claim 16 comprises a “roll-off reducing agent”. There is no disclosure corresponding to roll-off reducing agent in the cited reference of Wake US ‘811. Thus, it follows that the present invention as recited in pending claims 16-21 are novel over Wake US ‘811.

Further, it is noted that polishing compositions corresponding to those in Wake US ‘811 are actually disclosed in the present specification as Comparative Examples II – 2 to 4. The polishing compositions of the present invention, which contain a roll-off reducing agent show a remarkably excellent roll-off reducing effect in comparison with these Comparative Examples. In this respect, please see Tables 3 and 4 in the instant specification (at pages 38-39). It can be seen from the results in Tables 3 and 4 that since the roll-off reducing agent of the present invention is contained in the inventive polishing compositions (Examples II-7 to II-15), the roll-

off can be reduced without lowering the polishing rate, as compared to a case where the roll-off reducing agent is not contained (Comparative Examples II-2 to II-4). For the Examiner's convenience Tables 3 and 4 from the instant specification (as published in US 20040132385 A1) are set forth below.

TABLE 3

Roll-Off Reducing Agent		Compounds (A)		Polishing Rate	Roll Off
Compound	Amount (Parts by wt.)	Compound	Amount (Parts by wt.)	(Relative Value)	(Relative Value)
Ex. II-7	Ammonium Sulfate 0.5	Citric Acid	1.0	1.09	0.73
Ex. II-8	Potassium Sulfate 0.5	Citric Acid	1.0	1.09	0.80
Ex. II-9	Sodium Sulfate 0.5	Citric Acid	1.0	1.08	0.92
Ex. II-10	Nickel Sulfate 0.5	Citric Acid	1.0	1.04	0.95
Ex. II-11	Aluminum Sulfate 0.5	Citric Acid	1.0	1.07	0.73
Ex. II-12	Ammonium Sulfate 2.0	Citric Acid	1.0	1.10	0.75
Ex. II-13	Ammonium Chloride 0.5	Citric Acid	1.0	0.94	0.78
Comp. Ex. II-2	—	Citric Acid	1.0	1.00	1.00

TABLE 4

Roll-Off Reducing Agent			Compounds (A)			Compounds (B)				
	Compound	Amount (Parts by wt.)	Compound	Amount (Parts by wt.)	Compound	Amount (Parts by wt.)	Compound	Amount (Parts by wt.)	Polishing Rate (Relative Value)	Roll Off (Relative Value)
Ex. II-14	Ammonium Sulfate	0.5	Citric Acid	1.0	—	—	Itaconic Acid	0.5	1.05	0.81
Ex. II-15	Ammonium Sulfate	0.5	Citric Acid	0.5	Oxalic Acid	0.5	Itaconic Acid	0.5	1.04	0.79
Comp.	—	—	Citric Acid	1.0	—	—	Itaconic Acid	0.5	1.00	1.00
Ex. II-3	—	—	Citric Acid	0.5	Oxalic Acid	0.5	Itaconic Acid	0.5	0.98	0.99
Comp.	—	—	Citric Acid	0.5	Oxalic Acid	0.5	Itaconic Acid	0.5	0.98	0.99
Ex. II-4	—	—	Citric Acid	0.5	Oxalic Acid	0.5	Itaconic Acid	0.5	0.98	0.99

Accordingly, for the above reasons, it is also submitted that the instant invention as recited in pending claims 16-21 is non-obvious over the cited art of Wake US '811 reference of record.

CONCLUSION

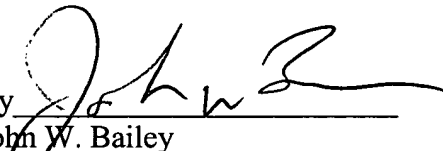
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of allowance, clearly indicating that each of pending claims 16-21 currently under consideration is allowable at present.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 21, 2005

Respectfully submitted,

By 

John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant